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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,899	11/30/2001	Howard Taub	10982142-1	3258
7590	10/12/2004		EXAMINER	
HEWLETT-PACKARD COMPANY			YOUNG, JOHN L	
Intellectual Property Administration			ART UNIT	PAPER NUMBER
P.O. Box 272400				
Fort Collins, CO 80527-2400			3622	

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/996,899	TAUB ET AL.
Examiner	Art Unit	
John L Young	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 November 2001.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-48 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-48 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.  
 PRIMARY EXAMINER

9-30-2004

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 9/30/2004

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

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## **FIRST ACTION REJECTION**

**(Paper# 9/30/2004)**

### **DRAWINGS**

1. This application has been filed with drawings that are considered informal; said drawings are acceptable for examination purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **ABSTRACT OBJECTION**

2. The ABSTRACT is over 150 words. Appropriate correction is required.

### **CLAIM REJECTIONS – 35 U.S.C. §101**

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

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3. Claims 30-38, 40-43 & 45-48 are rejected under 35 U.S.C. 101, because said claims are directed to non-statutory subject matter.

As per claims 30-38, 40-43 & 45-48, as drafted said claims are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430 (CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b), even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75, 47 USPQ 2d at 1602 (Fed Cir. 1998); *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05( q )).

### **CLAIM REJECTIONS – 35 U.S.C. §103( a )**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-48 are rejected under 35 U.S.C. §103( a ) as being obvious over Marks US 2001/0034651 (10/25/2001) (herein referred to as "Marks").

As per independent claim 1, Marks (the ABSTRACT; and FIG. 1) discloses: "*An incentive benefit program compensates customers for viewing advertising. . .*" Marks (¶[0049]) discloses: "*The credits may be stored in a customer's account at the web site. . .*"

Marks (¶[0047]) discloses: "*Wireless devices used in conjunction with the present invention may comprise the user terminal and receive, store and display information about the benefit as a bar code on a viewing screen or a print out. . .*"

Marks (¶[0017]) discloses: "*the consumer performs an action to verify that he has seen. . .*" an advertisement or email.

Marks (¶[0040]) discloses: "*The terminal from which a credit was earned may be identified using standard billing and crediting procedures. . .*"

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Marks (¶[0035]) discloses: “*methods of verifying and valuing ad viewing activities are described in U.S. patent application [to Marks] Ser. No. 09/774559, ‘Providing Benefits by the Internet to Minimally Identified Users’ filed Feb. 1, 2001.*”

Marks (the ABSTRACT; FIG. 1; ¶¶[0017]; [0018]; [0028]; [0029]; [0031]; [0035]); [0040]; [0042]; [0047]; [0049]; and [0052]) **implicitly shows all the elements** and limitations of claim 1; however,

Marks lacks explicit recitation of “**a sender bank identifier. . .**”

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Marks (¶[0049]) implicitly shows “**a sender bank identifier. . .**” elements and limitations not explicitly recited, and it would have been obvious to modify and interpret the disclosure of Marks cited above as implicitly showing those elements and limitations not explicitly recited, because modification and interpretation of the cited disclosure of Marks would have provided means for “*immediate or near term gratification for responding to Internet advertising. . .*” (see Marks (¶[0012])), based on the motivation to modify Marks so as to provide means which “encourages customers to conduct business and view advertising at locations where advertisements participating in the program are presented.” (See Marks (¶[0012]).

As per dependent claims 2-12, Marks implicitly shows the method of claim 1 and subsequent base claims depending from claim 1.

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Marks (the ABSTRACT; FIG. 1; ¶¶[0017]; [0018]; [0028]; [0029]; [0031]; [0035]); [0040]; [0042]; [0047]; [0049]; and [0052]; and whole document) implicitly shows all of the elements and limitations of claims 2-12; however,

Marks lacks explicit recitation of some of the elements and limitations of claims 2-12.

“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 2-12, were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Marks cited above as showing all of the elements and limitations of claims 2-12, because modification and interpretation of the cited disclosure of Marks would have provided means for “*immediate or near term gratification for responding to Internet advertising. . .*” (see Marks (¶[0012]), based on the motivation to modify Marks so as to “[encourage] customers to conduct business and view advertising at locations where advertisements participating in the program are presented.” (See Marks (¶[0012])).

Independent claim 13 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 14-21, Marks implicitly shows the e-mail program of claim 13 and subsequent base claims depending from claim 13.

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Marks (the ABSTRACT; FIG. 1; ¶¶[0017]; [0018]; [0028]; [0029]; [0031]; [0035]); [0040]; [0042]; [0047]; [0049]; and [0052]; and whole document) implicitly shows all of the elements and limitations of claims 14-21; however,

Marks lacks explicit recitation of some of the elements and limitations of claims 14-21.

“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 14-21, were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Marks cited above as showing all of the elements and limitations of claims 14-21, because modification and interpretation of the cited disclosure of Marks would have provided means for *“immediate or near term gratification for responding to Internet advertising. . . .”* (see Marks (¶[0012]), based on the motivation to modify Marks so as to “[encourage] customers to conduct business and view advertising at locations where advertisements participating in the program are presented.” (See Marks (¶[0012])).

Independent claim 22 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 23-29, Marks implicitly shows the system of claim 22 and subsequent base claims depending from claim 22.

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Marks (the ABSTRACT; FIG. 1; ¶¶[0017]; [0018]; [0028]; [0029]; [0031]; [0035]); [0040]; [0042]; [0047]; [0049]; and [0052]; and whole document) implicitly shows all of the elements and limitations of claims 23-29; however,

Marks lacks explicit recitation of some of the elements and limitations of claims 23-29.

“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 23-29, were well known and expected in the art by one of ordinary skill at the time of the invention because, for example, it would have been obvious to modify and interpret the disclosure of Marks cited above as showing all of the elements and limitations of claims 23-29, because modification and interpretation of the cited disclosure of Marks would have provided means for “*immediate or near term gratification for responding to Internet advertising. . .*” (see Marks (¶[0012]), based on the motivation to modify Marks so as to “[encourage] customers to conduct business and view advertising at locations where advertisements participating in the program are presented.” (See Marks (¶[0012])).

Independent claim 30 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 31-39, Marks implicitly shows the method of claim 30 and subsequent base claims depending from claim 30.

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Marks (the ABSTRACT; FIG. 1; ¶¶[0017]; [0018]; [0028]; [0029]; [0031]; [0035]); [0040]; [0042]; [0047]; [0049]; and [0052]; and whole document) implicitly shows all of the elements and limitations of claims 31-39; however,

Marks lacks explicit recitation of some of the elements and limitations of claims 31-39.

“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 31-39, were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Marks cited above as showing all of the elements and limitations of claims 31-39, because modification and interpretation of the cited disclosure of Marks would have provided means for “*immediate or near term gratification for responding to Internet advertising. . .*” (see Marks (¶[0012]), based on the motivation to modify Marks so as to “[encourage] customers to conduct business and view advertising at locations where advertisements participating in the program are presented.” (See Marks (¶[0012])).

Independent claim 40 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 41-48, Marks implicitly shows the method of claim 40 and subsequent base claims depending from claim 40.

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Marks (the ABSTRACT; FIG. 1; ¶¶[0017]; [0018]; [0028]; [0029]; [0031]; [0035]); [0040]; [0042]; [0047]; [0049]; and [0052]; and whole document) implicitly shows all of the elements and limitations of claims 41-48; however,

Marks lacks explicit recitation of some of the elements and limitations of claims 41-48.

“Official Notice” is taken that both the concepts and the advantages of all of the elements and limitations of claims 41-48, were well known and expected in the art by one of ordinary skill at the time of the invention because; for example, it would have been obvious to modify and interpret the disclosure of Marks cited above as showing all of the elements and limitations of claims 41-48, because modification and interpretation of the cited disclosure of Marks would have provided means for “*immediate or near term gratification for responding to Internet advertising. . .*” (see Marks (¶[0012]), based on the motivation to modify Marks so as to “[encourage] customers to conduct business and view advertising at locations where advertisements participating in the program are presented.” (See Marks (¶[0012])).

## CONCLUSION

5. Any response to this action should be mailed to:

Commissioner for Patents  
P. O. Box 1450  
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Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh Floor Receptionist  
Crystal Park V  
2451 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

September 30, 2004